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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,077	11/27/2001	Jeffry J. Grainger	020313-000710US	1100
20350	7590	12/09/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/996,077	Applicant(s) GRAINGER, JEFFRY J.	
	Examiner Janice A. Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on November 27, 2001, wherein claims 1-17 are pending.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on March 11, 2003 is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al (US 6,434,580) (hereinafter referred to as Takano) in view of Serbinis et al (US Patent 6,584,466) (hereinafter referred to as Serbinis) and further in view of Gross et al (US 6,918, 082) (hereinafter referred to as Gross).

Referring to Claims 1 and 13-17:

Takano discloses a computer-implemented method and system for managing documents related to a patent application, the method comprising:

a server system, wherein upon receipt of a first signal indicating a request to submit an invention disclosure or a draft patent application for approval, causes the server system to generate a message that requests approval to prepare a patent

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application for said invention disclosure or comments on the draft application, and routes said message to a second client system (*Figure 2 A6 invention report information sent to server computer 300; col. 6, line 27-31 the server computer 300 comprises a draft receiving means 301 and a draft entry means 302. In a memory unit 310 connected to this computer 300 is stored a specification file 303 which contains a specification file management table 304; col. 8, lines 7-11 upon registration of the draft data for the specification for patent application and pertinent piece of invention report information into the server computer 300 as described above, the patent-application-filing persons are enabled to revise the draft data on the client computer 200; col. 8, lines 33-37 the draft revision means 202 actuates known text preparation software and drawing software to let the patent-application filing persons use the software to revise the draft data for the specification for patent application fetched by the draft downloading means 201 (step A11).*

storing a first invention disclosure or draft patent application in a memory unit accessible by said server system (*col. 6, lines 27-31; the server computer 300 comprises a draft receiving means 301 and a draft entry means 302. In a memory unit 310. in a memory unit 310 connected to this computer 300 is stored a specification file 303, which contains a specification file management table 304*);

receiving, at the server system, a signal from a client system indicating a request to submit the first invention disclosure for review (*col. 12, lines 8-13 the notification means 108 notifies, by electronic mail, the patent-application-filing persons using the client computer 200 of the fact that the draft uploading means 103 has transmitted the*

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draft data for the specification for patent application and the piece of invention report information on the draft data to the server computer 300); and

the server system generates a message requesting approval of a second client system to prepare a patent application from the first invention disclosure or comments on the draft patent application and to communicate the message to the second client system (*col. 12, lines 14-19 the notification means 204 notifies, by electronic mail, the inventor using the client computer 100 of the fact that the draft uploading means 203 has transmitted the draft data for the specification for patent application and the piece of invention report information on the draft data to the server computer 300; col. 15, lines 12-19*).

Takano discloses a specification file management table (304) (*col. 7, lines 45-51*) and "checking" being corrections or supplementations done by the inventor and "revisions" being those done by the patent-application filing persons (*col. 10, lines 8-29*). Takano does not explicitly disclose a workflow rule stored on the server system or that the request is to get approval or solicit comments on the draft or that the memory unit is a database.

Serbinis discloses workflow information (Figure 2 (61), *col. 2, lines 52-57; col. 10, lines 23-34*) and a database for storing the documents (*col. 5, lines 26-35*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the drafting and preparation method and system of Takano the workflow information and database as taught in Serbinis to provide an Internet-based document management system and method that permit users to access a

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plurality of services supported by a common Internet-based database for collaborative file sharing and document distribution.

Gross discloses approval of a document (Figure 4 (112); col. 4, lines 43-47) and allowing for comments to be relayed upon viewing and/or proofing the document (col. 6, lines 49-52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the drafting and preparation method and system of Takano the ability to approve and comment on the documents upon review as taught in Gross to allow the reviewers to relay their comments and decisions on the document back to the server so the document creator may access it or to indicate that the document version is final via the approval command.

Referring to Claim 2:

Gross discloses wherein the message is an alert that when read, allows the second client system to select to approve or disapprove preparation of the document and wherein after the second client system makes a selection, stores the selection in the database (col. 4, lines 43-47; col. 4, line 55 thru col. 5, line 2; col. 6, lines 49-59).

Referring to Claim 3:

Gross discloses wherein if the second client system selects to approve preparation of the document, the server system generates a second message indicating the document has been approved for preparation (col. 4, line 43 thru col. 5, line 2).

Referring to Claim 4:

Takano discloses wherein the message is communicated to a client system associated with a patent law firm (*col. 6, lines 5-15 the client computer is used by a person of the patent application processing department of a company or a person of a patent attorney's office requested by the company to file the patent application*).

Referring to Claim 5:

Takano discloses wherein the server system includes an access management system that assigns client systems to one or more user groups and assigns data and documents stored in the database to one or more user groups, and wherein the access management system allows a client system connected to the server system to access data and/or documents if the client system is assigned to the same group as the data and/or document (*Figure 3 and col. 7, lines 11-27, Figure 4 and col. 7, line 52 thru col. 8, line 24 displays on a display unit a list of all the pieces of invention report information registered in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department]; col. 10, lines 8-29*).

Referring to Claim 6:

Takano discloses wherein the first and second client systems are associated with a first technology developer and assigned by the server system to a first user group, said invention disclosure is part of a Case Data Unit assigned to the first user group, the third client system is assigned to a second user group different from the first user group and in response to the second client system approving preparation of the patent

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application, the server system also assigns the invention disclosure to the second group (Figures 3-5, 14, 17 and col. 3, line 32 thru col. 4, line 55)

Referring to Claim 7:

Serbinis discloses workflow rules (Figure 2, (61) and col. 6, lines 34-46).

Serbinis does not disclose that the rules are associated with the technology developer.

However, Takano discloses the association with the technology developer (*Figure 3 and col. 7, lines 11-27, Figure 4 and col. 7, line 52 thru col. 8, line 24 displays on a display unit a list of all the pieces of invention report information registered in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department]; col. 10, lines 8-29).*

Referring to Claim 8:

Takano discloses wherein the client system sends signal to the server system over the Internet (col. 1, lines 8-18).

Referring to Claim 9:

Takano discloses wherein the first client system uploads the invention disclosure to the server system as part of the submission process (col. 7, lines 27-34).

Referring to Claim 10:

Takano discloses wherein the first client system creates the invention disclosure under the guidance of pages generated by the system (col. 6, line 44 thru col. 7, line 26; col. 7, line 52 thru col. 8, line 6).

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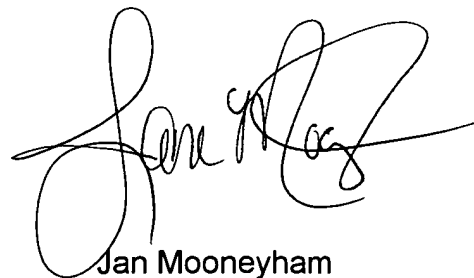
Referring to Claims 11-12:

Serbinis discloses wherein said message includes a link to documents (col. 1, lines 36-42; col. 1, line 63 thru col. 2, line 9).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a large, stylized loop at the end.

Jan Mooneyham
Patent Examiner
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